

R E M A R K S

The Examiner has renumbered Claims 12-34 according to 35 CFR 1.126. Renumbered Claims 1-28 and 32-34 are currently pending in the present application. In the instant Office Action, the Examiner raised a number of issues which are set forth by number in the order they are herein addressed:

- 1) Claims 2 and 23 stand rejected under 35 U.S.C. §112, first paragraph as allegedly failing to comply with the written description requirement;
- 2) Claims 23, 24 and 28 stand rejected under 35 U.S.C. §102(b), as allegedly anticipated by octadecanol (steryl alcohol); and
- 3) Claims 1-27 and 32-33 stand rejected under 35 U.S.C. §103(a), as allegedly unpatentable over Pungs (U.S. Patent No. 1,950,814), in view of Egan (U.S. Patent No. 1,935,946).

Applicants hereby amend the dependency of renumbered Claims 12-16, 18-22, and 24-28. In addition, Applicants hereby amend Claims 1, 23 and 34, and hereby cancel Claims 2, 11, 32, and 33, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments. Applicants reserve the right to prosecute the original, similar, or broader Claims in one or more future application(s). These amendments do not introduce new matter and are not intended to narrow the scope of any of the claims within the meaning of *Festo*.¹

1) The Claims Meet the Written Description Requirement

The Examiner has rejected Claims 2 and 23 under 35 U.S.C. §112, first paragraph as allegedly failing to comply with the written description requirement. The Examiner argues:

"[t]here is no support in the original filed application for the limitation of 'wherein said fatty alcohol comprises at least 25% by weight of said composition.' The language at least 25% encompasses proportions that are not present in the specification. The examples of Table V include various proportions for the fatty alcohol, but does not include 26% or 40% or 48% or 58%" (Final Office Action, page 3).

¹ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, No. 95-1066, 2000 WL 1753646 (Fed. Cir. Nov. 29, 2000).

Applicants must respectfully disagree. Nonetheless, Applicants have amended Claim 1 to include the limitation of Claim 2, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments, and while reserving the right to prosecute the original, similar, or broader claims in one or more future application(s). Support in the application as filed for the limitation in question is provided in part by original Claims 2 and 30 which recite "wherein said fatty alcohol comprises at least approximately 5% by weight of said candle," in combination with specific examples of candles comprising 25%, 30%, 35%, 45%, 50%, and 100% fatty alcohol (*See*, Tables V and VI). Thus in contrast to the Examiner's assertion, the original disclosure clearly encompasses candle compositions comprising at least 25% fatty alcohol, including compositions comprising 26%, 40%, 48% or 58% fatty alcohol. Applicants therefore respectfully request that the written description rejection of pending Claims 1 and 23 (reciting "wherein said fatty alcohol comprises at least 25% by weight) be withdrawn.

2) The Claims Are Novel

The Examiner has rejected Claims 23, 24 and 28 under 35 U.S.C. §102(b), as allegedly anticipated by octadecanol (steryl alcohol). Applicants respectfully disagree that the octadecanol anticipates the claimed candle compositions. Nonetheless, Applicants have amended Claim 23, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments, and while reserving the right to prosecute the original, similar, or broader claims in one or more future application(s). Specifically, Applicants have amended Claim 23 to recite "and a wick." Support for this amendment is found, for example, in the description which teaches "[c]andle 10 includes a wick 12 that is provided within candle material 14" (Specification, at page 6, lines 28 and 29). Applicants respectfully request that the anticipation rejection of pending Claims 23, 24, and 28, be withdrawn.

3) The Claims Are Patentable Over Pungs In View of Egan

The Examiner has rejected 1-27 and 32-33 under 35 U.S.C. §103(a), as allegedly unpatentable over Pungs (U.S. Patent No. 1,950,814) in view of Egan (U.S. Patent No. 1,935,946) stating:

Pungs teaches a candle composition comprising free fatty alcohols that are prepared from montan waxes or vegetables. The alcohols have 14 or more carbon atoms and a melting point of above 45°C. The alcohol is present in the candle composition in an amount from 1.5 to 20% (see lines 1-54). The candle base material may be paraffin wax, stearine, stearic acid or synthetic fatty acids (see lines 55-68). Pungs teaches that the candles have non-smoky flames (see lines 84-88). Pungs teaches the limitations of the claims other than the differences that are discussed below.

Pungs fails to teach the claimed IV; however, it would have been obvious to one of ordinary skill in the art to have prepared the composition possessing the claimed IV because Pungs teaches saturated fatty alcohols in combination with paraffin wax and/or stearic acid or stearine (saturated compounds).

Pungs differs from the claims in that he does not teach hydrogenated free fatty acids. However, Egan teaches this difference.

Egan teaches a candle composition wherein natural oils are hydrogenated to an IV of 5 or lower and separates the fatty acid from the oil (see lines 1-15, 33-54).

It would have been obvious to one of ordinary skill in the art to have substituted hydrogenated stearic acid for stearic acid because Egan teaches that hydrogenated stearic acid allows the candle maker to use less refined paraffin wax (see lines 28-41).

Applicants respectfully disagree that pending Claims 1-27, 32, and 33 are obvious over Pungs in view of Egan. Nonetheless, Applicants have amended Claims 1 and 34, and have canceled Claims 2, 11, 32 and 33, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments, and while reserving the right to prosecute the original, similar, or broader claims in one or more future application(s). In particular, Applicants have amended Claim 1 to include the at least 25% fatty alcohol limitation of canceled Claim 2, and have amended Claim 34 as an independent claim including the paraffin limitation of canceled Claim 11. In addressing this rejection, Applicants largely focus on independent Claims 1, 17, 23, and 34, since non-obviousness of an independent claim necessarily leads to non-obviousness of claims dependent therefrom. Applicants respectfully point out that the claimed invention is directed to candles or candle compositions with specific limitations: at least 25% by weight fatty alcohol (Claims 1 and 23); iodine value of 2 or less (Claim 17); and two or more of triglycerides, free fatty acids, and fatty alcohols (Claim 34).

All Claim Limitations are neither Taught nor Suggested

The Examiner is reminded that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art."² In the first place, Claims 1, 3-10, and 23-28 require that the **fatty alcohols** comprise **at least 25% by weight** of said composition. In contrast, the primary reference (Pungs) discloses that the fatty alcohol component of the candle composition should be between 1.5 and 20 per cent, and teaches candle compositions consisting of from 2 to 18 per cent fatty alcohol (*See*, lines 3-11 and Table 1), while the secondary reference (Egan) discloses candle compositions lacking a fatty alcohol component.

The Examiner counters that "a prima facie case of obviousness exists where the claimed ranges and the prior art ranges do no overlap, but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals v. Banner*, 227 USPQ 773 (Fed. Cir. 1985)." However, the Examiner has not provided any factual support that 25% is close to the ranges in the prior art. It is the Examiner's burden to demonstrate this in order to support the rejection. Thus, without more, the rejection must be withdrawn.

Applicants respectfully disagree with the Examiner's assumption that a candle comprising between 1.5 and 20% by weight of a fatty alcohol would have the **same** properties as a candle comprising at least 25% by weight of a fatty alcohol. Applicants provide factual evidence showing the contrary, highlighting why the rejection is improper. Specifically, as evidenced by the Declaration of Jerome Bertrand, attached hereto at Tab 1, the claimed candle compositions possess superior attributes including but not limited to a more controlled burn profile, less shrinkage, and improved ability to receive fragrances and dyes.

In the second place, Claims 12-16 and 34 require **paraffin and two or more of triglycerides, free fatty acids, and fatty alcohols**. In contrast, both Pungs and Egan teach compositions consisting of paraffin and one fatty material; Pungs discloses compositions consisting of a fatty alcohol and paraffin (or other non-fibrous combustible substance), while Egan discloses compositions consisting of a free fatty acid and paraffin. In addition, Applicants note that the Examiner did not list Claim 34 among the claims rejected as obvious over Pungs in view of Egan. Applicants respectfully remind the Examiner that Claims 12-16

² *See, In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

depend upon Claim 34 and thus also should not be rejected over the Pungs/Egan combination.


Thirdly, Claims 17-22 require an **Iodine Value of approximately 2 or less**. In contrast, Egan discloses a fatty acid derived from a hydrogenated oil with an IV of 5 or lower, while Pungs fails to disclose iodine values for any of the non-fibrous combustible substances listed as suitable for candle production. Thus, even if combined, the teachings of Pungs and Egan could not be expected to yield a candle composition in which the **total fatty material** (e.g., not simply the free fatty acid component) has an Iodine Value of approximately 2 or less.

As a *prima facie* case of obviousness has not been established, Applicants respectfully request that this rejection be withdrawn.

CONCLUSION

Applicants believe that the amendments and arguments set forth above traverse the Examiner's rejections and, therefore, request that these grounds for rejection be withdrawn. However, should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicants encourage the Examiner to call the undersigned collect.

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Christine A. Lekutis
Registration No. 51,934

MEDLEN & CARROLL, LLP
101 Howard Street, Suite 350
San Francisco, California 94105
415.904.6500